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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,547	10/27/2003	Tomohiro Ishikawa	86409AEK	2409

7590 07/21/2006
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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/694,547	Applicant(s) ISHIKAWA ET AL.	
	Examiner Lawrence D. Ferguson	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed May 9, 2006.

Claims 1, 8, 10 and 20 have been amended and claim 2 was cancelled rendering claims 1 and 3-20 pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 3-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elman et al (U.S. 6,937,310).

Elman discloses an optical multilayer comprising a polymeric substrate made out of triacetylcellulose, which has a non-zero out of plane birefringence and an amorphous polymeric overlayer having an out of plane birefringence that is more negative than -0.005 throughout the range of 370 nm and 700nm (column 4, line 66 through column 5, line 19 and column 6, lines 42-53). Elman further discloses the polymers contain non-visible chromophore groups in the polymer backbone (column 6, lines 60-67 and claim 15). The glass transition temperature (T_g) of the polymers used in the amorphous layer

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above 180°C, where the thickness of the polymer layer is less than 30um and the film has a transmission of greater or equal to 90% (column 7, lines 5-25). The substrate has a thickness of 80um (.08mm) and the polymeric layer has a vinylbiphenol component (column 9, lines 5-44 and column 10, lines 23-45). Elman discloses the substrate may be comprised of polycarbonate (column 14, lines 15-20). Elman teaches the invention is used for Liquid crystal displays which have polarizers and image devices with color reproduction (column 1, lines 20-21 and 40-60).

Elman does not explicitly disclose the polymeric overlayer is positive or more positive than 0.005. Elman discloses an optical multilayer comprising a polymeric substrate and an amorphous polymeric overlayer having an out of plane birefringence that is more negative than -0.005 throughout the range of 370 nm and 700nm (column 4, line 66 through column 5, line 19 and column 6, lines 42-53). Elman further teaches a typical liquid crystal device has a positive out of plane birefringence and the birefringence increase towards the shorter wavelength (column 3, lines 38-50). Although Elman does not explicitly disclose the polymeric overlayer is positive or more positive than 0.005, the out of plane birefringence is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the out of plane birefringence, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. out of plane birefringence) fails to render claims patentable in the absence of unexpected results. The out of plane birefringence is optimizable as it

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directly affects the orientation of the multilayer. It would have been obvious to one of ordinary skill in the art to make the optical multilayer with the limitations of the positive out of plane birefringence since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

Response to Arguments

4. Objection of claim 13 is withdrawn due to Applicant amending the claims in compliance to the objection.

Rejection made under 35 U.S.C. 102(e) as being anticipated by Elman et al (U.S. 6,937,310) is withdrawn due to Applicant incorporating the limitations of claim 2 into claim 1.

Applicant argues the preceding Statement of Common Ownership” brings into play 35 USC 103(c) which prohibits the Examiner using the Elman patent as a reference through section 102(e). In order to exclude the Elman reference based upon common ownership, Applicant must submit the required statement (see MPEP 706.02(I)) for example, that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. Applicant has failed to include this statement, therefore, the rejection made under 35 U.S.C. 103(a) as being unpatentable over Elman et al (U.S. 6,937,310) is maintained for reasons of record.

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.


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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 7/18/04